

*Albert et al.*  
Serial No. 10/711,238  
Amendment of July 21, 2006  
Page 6

## **AMENDMENTS TO THE DRAWINGS**

Please replace the second sheet of drawings filed with this application with the amended sheet of drawings appearing on the following page.

## REMARKS

The amendments in the specification simply insert patent numbers for three applications originally identified only by serial number.

Claim 1 has been amended to specify that the surface of the adhesive remote from the display medium forms an external surface of the display. This amendment is based upon, *inter alia*, Figures 5A-5F and the corresponding description at Paragraphs 69-75 of the specification. All of Figures 5A-5F clearly show the "outer" surface of the display medium forming an external surface of the display. Furthermore, it will readily be apparent that the process of claim 10 could not be carried out unless the adhesive layer was exposed on an external surface of the display.

Claims 2-9 are unchanged. Claim 10 has been amended in a manner exactly similar to claim 1. Claims 11-15 are unchanged.

Claims 16-20 have been added to give applicants the full scope of the protection to which they consider themselves entitled. Claim 16 is directed to an electrically active display according to claim 1 further comprising at least one rear electrode disposed between the display medium and the adhesive layer; this claim is based upon, *inter alia*, Figures 5D and 5E and the related description at Paragraphs 73-75 of the specification. Both these Figures show rear electrodes 82 interposed between the display medium 46 and the adhesive layer 64. Claim 17 is directed to an electrically active display according to claim 16 wherein at least the portion of the adhesive layer covering the at least one rear electrode is conductive; this claim is based, *inter alia*, on the statements in Paragraphs 73 and 74 that the adhesive layer 64 is conductive.

Claim 18 corresponds essentially to original claim 1 of this application with the addition of the feature of claim 16. Accordingly, it is believed that the basis for claim 18 will readily be apparent from the above discussion of claim 16. (Original claim 1 did not use the term "first" or "second" electrode, but it is manifestly necessary to distinguish between the two electrodes and use of the terms "first" or "second" is conventional and introduces no new subject matter.) Claim 19 exactly parallels claim 17

but depends from claim 18. Claim 20 corresponds essentially to original claim 10 of this application with the addition of the feature of claim 16. Accordingly, it is believed that the basis for claim 18 will readily be apparent from the above discussion of claim 16.

The amended sheet of drawings simply introduces the reference numeral 48 into Figure 5E for consistency with the last sentence of Paragraph 74 of the specification; this sentence unambiguously identifies the integer which needs to be labeled 48.

No new matter is introduced by any of the foregoing amendments.

Claims 1-15 are pending in this application and all claims are rejected. Claims 8, 9 and 11 stand rejected under 35 USC 112, second paragraph. This rejection is traversed. It appears from the wording of this rejection that the Examiner is reading the word "via" in claims 8, 9 and 11 as a preposition when in fact the term is being used as a noun meaning, in accordance with accepted usage in the display industry, an electrical conductor passing through a layer cf. the use of the same term in Paragraphs 71, 72 and 74 of the specification. Having regard to this use in the specification, it is respectfully submitted that the phrases which were objected to in claims 8, 9 and 11 are clear in context and satisfy 35 USC 112, second paragraph. If, however, the Examiner still feels a change in nomenclature is required, he is invited to telephone the undersigned attorney to agree an appropriate change in wording of the relevant claims.

In response to the obviousness-type double patenting rejection set out in Paragraphs 2-4 of the Office Action, applicants are filing herewith a Terminal Disclaimer disclaiming any portion of the term of any patent granted on this application which extends beyond the term of U.S. Patent No. 6,825,829. With regard to the required common ownership, it is respectfully noted that the present application is a continuation of Application Serial No. 09/141,126, filed August 27, 1998, which matured into U.S. Patent No. 6,825,829 (see Paragraph 1 of the specification, as amended above) and that the Assignment already recorded on October 26, 1998 in relation to Application Serial No. 09/141,126 at Reel 9544, Frames 994-998, explicitly assigns not only Application

Serial No. 09/141,126 but all continuations thereof. Accordingly, this single recorded Assignment assigned both Application Serial No. 09/141,126 and the present application to the same assignee, namely E Ink Corporation. Furthermore, the undersigned attorney, who is the Intellectual Property Counsel of the aforementioned E Ink Corporation, hereby affirms, on the basis of his own knowledge and E Ink's corporate records, that no further assignment of either U.S. Patent No. 6,825,829 or the present application has been made beyond that effected by the aforementioned recorded Assignment, and that accordingly E Ink Corporation is the assignee of all right, title and interest in and to U.S. Patent No. 6,825,829 and the present application. Accordingly, the enclosed Terminal Disclaimer must be sufficient to overcome the double patenting rejection.

Claims 1-4, 6, 10, 12 and 14 stand rejected under 35 USC 102(b) as anticipated by Tojima et al., U.S. Patent No. 5,368,780. This rejection is traversed. More specifically, this rejection is traversed on the grounds that Tojima does not disclose an electrically active display comprising a display medium and an adhesive layer disposed on the display medium such that the surface of the adhesive remote from the display medium forms an external surface of the display, as required by claim 1, nor does Tojima disclose a process in which such a display is formed and attached to a receiving surface by means of the adhesive layer, as required by claim 10.

The only structures disclosed in Tojima which could conceivably anticipate the present claims are the evaluation cells shown in Figures 2, 3, 5 and 6 of Tojima. The cell shown in Figures 2 and 3 does not have the arrangement of display medium, optically transmissive electrode and adhesive layer required by all the present claims; the claims require that the display medium having first and second surfaces *on opposed sides thereof*, with the electrode in contact with the first surface and the adhesive layer disposed on the second surface. In more colloquial terms, the present claims require that the display medium be sandwiched between the electrode and the adhesive layer. This is not the arrangement shown in Figures 2 and 3 of Tojima, in which the adhesive layer 4 extends between the two electrodes 3, thus forming a closed cell within which the

display medium 1, 5 is confined. (Incidentally, the undersigned attorney reserves the right to argue that the self-evidently cured epoxy edge seal 4 in Tojima's Figures 2 and 3 is not an adhesive layer as required by the present claims, since in its cured form it cannot be used to adhere the display to anything else.)

With regard to claim 10, the Examiner has stated that the cell of Tojima's Figure 2 is produced by a process according to claim 10, and has directed to column 6, lines 65-66 of Tojima. With respect, column 6, lines 65-66 of Tojima prove that the cell of Figure 2 is not produced by a process of present claim 10. Claim 10 in effect requires that the aforementioned electrode/display medium/adhesive layer sandwich be formed and thereafter that this sandwich be attached to the receiving surface by means of the adhesive layer. This process requires that the display medium have sufficient mechanical integrity to hold the sandwich together until the sandwich can be secured to the receiving surface, and hence cannot be practiced with a liquid display medium such as the medium 1, 5 shown in Tojima's Figure 2. In fact, as clearly stated at column 6, line 65 to column 7, line 2 of Tojima, the display medium is filled into a completed cell which already comprises the glass substrates 2, the electrodes 3 and the edge seal 4 in the same way as in the conventional manufacture of liquid crystal displays. This type of filling process is compelled by the liquid display medium used in Tojima and is not a process in accordance with present claim 10.

The situation with regard to the cell shown in Tojima's Figures 5 and 6 is more complex. In the final form shown in Figures 5 and 6, this cell does not anticipate claim 1 since neither adhesive layer forms part of an external surface of the display. However, there still remains the question of whether an intermediate stage in the production of this cell might anticipate claim 1. The only description of the preparation of the cell is the very short passage at column 7, lines 36-47, which entirely fails to mention the two adhesive layers shown in Figure 6. However, reading between the lines of this passage, it is clear that the cell of Figures 5 and 6, and the method for its production, do not anticipate any of the present claims. The passage in column 7 states that "the mesh

film [i.e., the microcell display medium layer of Figure 6] was formed of a photosensitive acrylate resin disposed on a film which composed [sic] of a PET . . . substrate and an ITO film disposed on the PET substrate" (column 7, lines 38-42). Given that Figure 6 shows an adhesive layer present between the ITO layer and the mesh film formed from the photosensitive resin, this must mean that the PET/ITO film was actually a PET/ITO/adhesive film, since it hardly practicable to provide an adhesive layer on what it, in effect, a layer of photoresist, which is normally coated in liquid form. Accordingly, when column 7 later states that "another film which composed of a PET substrate and an ITO film disposed on the PET substrate was disposed on the mesh film so as the hold the suspension containing the herapathites therebetween" must mean that a PET/ITO/adhesive layer film was used. (Given the choice between trying to coat an adhesive over a series of microcells filled with liquid and separated by solid walls, or trying to coat the adhesive over a uniform ITO layer on a PET substrate, it defies common sense to suggest that the former course would be adopted.) The resultant process, which does not form an electrode/display medium/adhesive layer sandwich, cannot anticipate either claim 1 or claim 10.

Since claims 2-4, 6, 12 and 14 depend from claim 1 or claim 10, these claims are also not anticipated by Tojima, for the reasons set out above.

The 35 USC 103(a) rejections set out in Paragraphs 8, 9 and 10 of the Office Action are traversed for the same reasons as the 35 USC 102 rejection discussed above. There is nothing in any of the secondary references to suggest modifying Tojima to produce a display or process in accordance with any of the present claims.

Claims 16 and 17 are patentable over the references of record for the same reasons as claim 1, as discussed above. Claims 18, 19 and 20 all require, in effect, the formation of a multi-layer structure in which the display medium is sandwiched between first and second electrodes, and an adhesive layer is provided on the side of the second electrode remote from the display medium. None of the references describe a structure

*Albert et al.*  
Serial No. 10/711,238  
Amendment of July 21, 2006  
Page 13

having an adhesive layer "outside" an electrode in this manner, and hence claims 18-20 are patentable over these references.

Since the normal period for responding to the Office Action expired May 22, a Petition for a two month extension of this period is filed herewith. The fees for this Petition, the attached Terminal Disclaimer and for the additional independent claim introduced by this Amendment, are being paid with this electronic filing.

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